

REMARKS

Status of the Claims

With entry of the above amendment, claims 1, 2, 4, 6-11, 13-17, 19, 21-26, 28-55, 59, 66, 68-74, 77, and 80 are pending. (Office Action, pages 1-3). No claims are currently withdrawn from consideration as being drawn to non-elected subject matter. (*Id.*, page 1.)

Applicant canceled claims 3, 5, 12, 18, 20, 27, 56-58, 60-65, 67, 75-76, and 78-79 without prejudice or disclaimer to the subject matter claimed therein. Applicant reserves the right to pursue any canceled subject matter in a continuation application.

Claims 1, 7, 8, 14, 22, 23, 74, and 77 were amended to more clearly recite the subject matter claimed therein. Support for all amendments are found in the specification as filed.

Specifically, amended claims 1, 7, 8, 14, 22, and 23 have been amended to recite "...wherein said hydrocarbons comprising 2 to 22 carbon atoms do not ~~may optionally~~ comprise at least one hetero atom..." Support for this amendment is found in the specification as filed, for example, at page 7, lines 4-13, the "unsaturated hydrocarbon" optionally comprises heteroatoms. "Optionally comprises" includes compounds that "do not comprise" heteroatoms.

Amended claims 74 and 77 have been amended to recite ".....wherein at least one of said R' groups is chosen from aryl groups, substituted with at least one hydrocarbon comprising 1 to 22 carbon atoms, wherein said hydrocarbon is chosen from linear and branched, unsaturated hydrocarbons." Support for this amendment is

found in the specification as filed, for example, in original claims 3 and 18, where R' is chosen from aryl groups.

New claim 80 has been added, and recites the subject matter of previous claims 1 and 6, as presented in the Response filed August 5, 2003. No new matter has been added.

I. The Claims Are Not Indefinite Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 2, 4, 6-11, 13-17, 19, 21-36, 28-55, 59, 66, and 68-79, are rejected as indefinite under 35 U.S.C. § 112, second paragraph. (Office Action, page 2.) The rejection of claims 75-76 and 78-79 is moot in view of the above amendment canceling those claims. The Office alleges that the recitation of R' is not clear where it states that "at least one of said R' groups is chosen from linear and branched, saturated and unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation" because "if R' has a carbon to carbon double bond, it could not be saturated." (*Id.*) Accordingly, the Office suggests that this "at least one" statement should be amended to delete "saturated". (*Id.*)

Applicant points out that only claims 1, 7, 8, 14, 22, and 23 formerly recited "...at least one of said R' groups is chosen from linear and branched, saturated and unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation...". In order to promote prosecution, Applicant amends claims 1, 7, 8, 14, 22, and 23 to recite "...at least one of said R' groups is chosen from linear and branched, ~~saturated and~~ unsaturated hydrocarbons comprising 2 to 22 carbon atoms

and one double unsaturation..." as suggested by the Office. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Regarding the rejection of claims 59, 66, 68, 70, 72-74, and 77, Applicant respectfully submits that these claims do not recite the language pointed to by the Examiner. Accordingly, the rejection of these claims appears to be not related to the language recited above. If necessary, Applicant respectfully requests clarification of the rejection in regards to these other claims that do not recite the language indicated by the Office.

The Office additionally requests clarification regarding whether "Applicant means C to C unsaturation in Applicant's definition of the at least [one] R' or is the Applicant referring to all other types of unsaturation such as C=O?" The Office also requests support from the specification for Applicant's definition. (*Id.*) In response, Applicant points out that the specification expressly defines "unsaturated hydrocarbon" as follows:

The expression 'unsaturated hydrocarbon' means a chain which comprises at least one C=C double bond or at least one C≡C triple bond, it being possible, needless to say, for said chain also to be optionally substituted with one or more groups chosen from aryl, ester, amide and urethane groups; and/or optionally to comprise one or more hetero atoms chosen from O, S and N; and/or optionally to be substituted with at least one substituent chosen from fluorine atoms and hydroxyl groups.

Specification, page 7, lines 4-9.

This definition clearly indicates that "unsaturated hydrocarbon" comprises at least one double or triple carbon-carbon bond. In addition, this definition also makes clear which optional substituents are possible. Accordingly, Applicant submits that one of ordinary skill in the art reading the specification would know the kinds of chain

unsaturation and kinds of chain substituents that are possible. For example, Applicant points out that one of skill in the art would know that C=O would be considered a chain substituent and that it is neither implied by, nor inherent in, Applicant's definition of "unsaturated hydrocarbon".

II. The Claims Are Not Anticipated Under 35 U.S.C. § 102

Bruenner

Claims 1, 2, 4, 6-10, 14-17, 19, 21-25, 33-36, 68, 70, and 74-79 are rejected as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,819,561 to Bruenner ("Bruenner"). (*Id.*, page 3.) Claims 11, 13, 26, 28-32, 37-55, 59, 66, 69, and 71-73 were not included in this rejection. (*Id.*) The Office alleges "Bruenner teaches a composition comprising a compound of instant formula I and mineral oil." (*Id.*) The rejection of claims 75-76 and 78-79 is moot in view of the above amendment canceling those claims. Applicant traverses the rejection of the remaining claims as follows.

In order to anticipate a claim under 35 U.S.C. § 102(b), the cited reference must disclose all of the recited limitations of the claim. In this instance, the Office does not indicate which of the compounds disclosed in Bruenner meet the limitations of the claims. Applicant submits, however, that none of Bruenner's compounds fall within the scope of the claims.

For example, the instant claims recite a cyclohexyl group, and three cyclohexyl species are disclosed in Bruenner at Table II, col. 7-8, as species numbers 5, 9, and 10. Of these, only species 10 comprises at least one unsaturated hydrocarbon chain, as

required in the present claims. Species 10 has all three R groups being –NHCON(oley_l)₂. The instant claims do not encompass species 10 because the corresponding Y group of formula (I) in the instant claims may be –NHCOR', but R' does not include N(oley_l)₂. The claims recite that at least one of said R' groups is chosen from linear and branched, unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation. Species 10 of Bruenner is an R' group that has 36 carbon atoms, which is outside the 2 to 22 carbon atom range recited in the claims.

Accordingly, Breunner's species 10 does not anticipate the current claims, nor do any other compounds disclosed in Bruenner. Withdrawal of this rejection is therefore requested.

Miniami

Claims 1, 2, 4, 7-9, 14-17, 22-25, 40, and 74-79, are rejected as being anticipated under 35 U.S.C. § 102(b) by JP 03120077 to Miniami *et al.* ("Miniami"). (Office Action, page 3.) . Claims 6, 10, 11 13, 19, 21, 26 28-39, 41-55, 59, 66, and 68-73 were not included in this rejection. The Office alleges "Miniami teaches a composition comprising a compound of instant formula I." (*Id.*) The rejection of claims 75-76 and 78-79 will be moot with entry of the above amendment canceling those claims. Applicant traverses the rejection of the remaining claims as follows.

Applicant has amended claims 1, 7, 8, 14, 22, and 23 to recite

...wherein at least one of said R' groups is chosen from linear and branched, ~~saturated and~~ unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation, wherein said hydrocarbons comprising 2 to 22 carbon atoms may optionally be substituted with at least one group chosen from aryl groups, ester groups, amide groups and urethane groups; wherein said hydrocarbons comprising 2 to 22 carbon

atoms ~~do not~~ ~~may optionally~~ comprise at least one hetero atom chosen from O, S and N; and wherein said hydrocarbons comprising 2 to 22 carbon atoms may optionally be substituted with at least one entity chosen from fluorine atoms and hydroxyl groups;...

Applicant has also amended claim 74 and 77 to recite

...wherein at least one of said R' groups is chosen from aryl groups, substituted with at least one hydrocarbon comprising 1 to 22 carbon atoms, wherein said hydrocarbon is chosen from linear and branched, unsaturated hydrocarbons.

Support for these amendments are found in as-filed specification as indicated above.

Miniami discloses 1,3,5-[CH₂=CH-O-(CH₂)₄-O-C(O)NH]₃-cyclohexyl at page 500, column 2. It appears that the claimed genus of formula (I) encompasses this species when each R = hydrogen, each Y = -NHCOR', and each R' is CH₂=CH-O-(CH₂)₄-O-. This R' group corresponds to an "unsaturated hydrocarbon" comprising 2 to 22 carbon atoms, one double unsaturation, and one or more hetero atoms chosen from O, S and N.

Amended claims 1, 7, 8, 14, 22, and 23 exclude heteroatoms in the recited R' unsaturated hydrocarbon group. Miniami discloses a species with heteroatoms in the recited R' unsaturated hydrocarbon group. (*Id.*) Accordingly, this example in Miniami does not anticipate the claims as amended.

Amended claims 74 and 77 require that at least one R' group is chosen from an aryl group. Accordingly, the indicated example in Miniami does not anticipate claims 74 or 77 as amended because Miniami's species does not include an aryl group at the R' position.

New claim 80 recites the language of prior claim 1 plus the limitations recited in claim 6, which was not rejected as anticipated by Miniami. Therefore new claim 80 should also not be anticipated by Miniami.

Accordingly, Applicant submits that Minimai does not anticipate any of the claims as currently pending. Applicant respectfully requests reconsideration and withdrawal of the rejection.

III. The Claims Are Not Obvious Under 35 U.S.C. § 103(a)

Claims 29-32, 37-39, 41-48, 50-55, 59, 69, and 71-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bruenner. (Office Action, page 3.) The Office alleges that it would have been obvious "to determine the optimum amount of oil. One would have been motivated to do this in order to make the most effective invention." (*Id.*) Applicant traverses the rejection as follows.

To establish a prima facie case of obviousness, an Examiner must meet three basic criteria, including that, (1) the prior art reference must teach or suggest all the claim limitations and (2) there must be some motivation in the art to modify the reference. In the present case, the Examiner has failed to make a prima facie case of obviousness because at least these two criteria have not been met.

Applicant traverses the rejection because Bruenner does not teach all the limitations of the instant claims as amended. As emphasized above, the amended claims recite that at least one of said R' groups is chosen from linear and branched, unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation. Species 10 of Bruenner is an R' group that has 36 carbon atoms, which is

outside the 2 to 22 carbon atom range recited in the claims. Accordingly, Breunner's species 10 does not teach all of the limitations of the rejected claims.

Bruenner also does not suggest the compounds recited in the claims because, for example, there is no evidence or argument of record that suggests at least one of the corresponding R' groups of Brunner could be chosen from linear and branched, unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation. Thus, Bruenner neither teaches nor suggests all the limitations of the instant claims.

In addition, in order to establish a prima facie case of obviousness there must be some motivation in the art to modify the reference. Applicant also submits that there is nothing in Bruenner to provide motivation to modify Bruenner's compounds to devise the claimed invention. For example, there is nothing in Bruenner to suggest modifying at least one of the corresponding R' groups of Brunner to be chosen from linear and branched, unsaturated hydrocarbons comprising 2 to 22 carbon atoms and one double unsaturation.

Accordingly, the Office has failed to show a prima facie case of obviousness according to MPEP § 2143. Applicant respectfully requests that the rejection be reconsidered and withdrawn.

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CONCLUSION

Applicant therefore respectfully requests reconsideration of the application, and the timely allowance of the pending claims. Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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